

## **REMARKS/ARGUMENTS**

Claims 1-25 and 34-37 are pending in the application. Claims 1-2, 4, 8, 12, 22, 34-35 and 37 have been amended and new claims 38-40 have been added. No new matter has been added. Reconsideration of the claims is respectfully requested.

Applicants thank the Examiner for conditional allowance of Claim 12.

In paragraph 7 on page 2 of the Office Action, claims 1, 4, 5, 8-10, 22, 25 and 37 are rejected under 35 U.S.C. §102 (b) as being anticipated by Cunningham (US Patent No. 2893144).

In paragraph 17 on page 6 of the Office Action, claims 35 and 36 are rejected under 35 U.S.C. §102 (b) as being anticipated by Turner (US Patent No. 4201403).

In paragraph 21 on page 7 of the Office Action, claim 2 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Cunningham (US Patent No. 2893144).

In paragraph 23 on page 8 of the Office Action, claims 3, 6, 18, 20 and 24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Cunningham (US Patent No. 2893144) in view of Cunningham (US Patent No. 3348324).

In paragraph 26 on page 8 of the Office Action, claims 7 and 21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Cunningham (US Patent No. 2893144) in view of Schneider (US Patent No. 5513459).

In paragraph 28 on page 9 of the Office Action, claims 11, 13-17, 19 and 23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Cunningham (US Patent No. 2893144).

In paragraph 34 on page 11 of the Office Action, claim 34 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Cunningham (US Patent No. 2893144).

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It is noted that an interview was conducted with the prior examiner of record where agreement was reached on the allowability of claim 4 (i.e. claim 1 + 4) subject to further search.

A further search has been conducted, but it is submitted that no new reference has been combined to render the pending claims obvious. Instead, the previously asserted prior art has merely been asserted again, this time without the benefit of the Swallow reference which has correctly been withdrawn.

The new examiner on this case is respectfully requested to consider the arguments with respect to the key references (Cunningham 144 and 324) which had been fully considered by prior examiners and on pre-appeal.

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Claim 1 of the present invention, provides specific structure which has a planar first surface which *bridges the gap*, called for later in the claim. (This has been added to the claim for clarity, but logic says that this feature was necessarily always part of claim 1 even prior to amendment.) This is a significant and important difference over both Cunningham references. Notice that Cunningham uses "filler strips" 29 and 30 which fill in portions of the top surface and leave gaps therebetween, **in the top surface**. (Notice that the top surface has not adhesive so there can be no doubt as to which is the top and which is the bottom – or first and second). The result is that Cunningham '144 would easily snag when inserted into a sheet feed printer, whereas the present invention may be feed thru without difficulty because of the plan top surface with which insures that the label will be substantially planar and thus capable of sheet feed printing. Roll printing as taught in Cunningham, has parallel printing rollers which sit either side of the gap and thus will not snag. Ink jet printers with a head which traverses across the label would be destroyed.

Neither Cunningham reference recognizes this problem nor its solutions and for good reason: it is only useable as a roll feed system where sheet feed printing problems do not arise.

Cunningham is furthermore an opposite teaching because indicia is not printed on the label itself, but on the insert 31 which is never part of the label structure.

Thus the fact that the first layer in Claim 1 is planar and bridges the gap is not shown in Cunningham and there is no teaching to suggest any reason to adopt such a modification.

Even more fundamental is that neither Cunningham reference recognizes the importance of creating a visually discernable fold line by using materials of different light transmissibility. Claim 1 refers to non-transparent materials of different light transmissibilities. In both Cunningham references only transparent materials are used and there is no mention of their light transmission characteristics as it is important that they transmit as much light as possible. In Cunningham '324, the indicia must be placed between the transparent sheets and in Cunningham '144 the layers are recited as transparent for the same reasons.

Claim 2 is further distinguishable in that it has an adhesive on the outer surface thereof. If Cunningham had such a surface, it could not receive insert 31, as its second surfaces would be stuck together! Cunningham's teaching is to put a preprinted indicia (31) *between* the second layers. The present claimed invention is the opposite. The indicia can be applied to the outside of the first layer but obviously not *between* second layers since they are adhesive, as claimed.

The second feature mentioned above, relates to the concept of the gap being *visually discernable*. As to *this* feature which the examiner has misapplied Cunningham and appears to fully disregard M.P.E.P sec 2142 (a section based in case law under *In re Vaeck*, 947 F.2d 488, 20 USPQ2nd 1438 (Fed.Cir. 1991).

The feature, of visual discernability, described in claims 9, 10, 13, 14, 22, 23, 30, 34 and 35, pointed out that the user can *see* the gap created by the two layers of material.

Cunningham teaches the opposite concept, i.e. that one can *feel* the gap, but not see it. Why? Because Cunningham only discloses the use of transparent material in both its first and second layers. And it *must* only employ translucent layers because the label is meant to have an indicia insert 31 slid between those layers. If they were not translucent, the indicia would be blocked from view. (See column 3 line 57-58)

So Cunningham has no teaching of using visually discernable material, (nor darker material or security material as recited in some claims) to define, and find, the gap.

Furthermore, this solution has another benefit which is not applicable to the Cunningham: if the label is used to cover a prior label, its opacity is important in preventing the underlying indicia from showing through. So, by creating a visually discernable gap, one necessarily controls opacity and thus gets the further benefit, not taught in Cunningham, of being able to block underlying indicia.

Claim 12 was considered allowable and had been made independent similar to the combination of claims 11 and 12.

Claim 11 should likewise be allowable because there is no reason, related to the cited art, why the second layer must provide greater light transmissibility than the first layer and not the reverse.

Likewise Claim 13 should be allowable for identical reasons as stated above.

The idea of security material in one of the layers as in claim 14 is not obvious. The examiner asserts that it is an obvious substitution but in fact, since Cunningham '144 in no way alludes the other the issue of light transmission for finding the gap, adding security material would not be an obvious additional feature.

Claim 22 is similar in scope to claim 12 and should therefore be allowable on the basis the claim 12 is allowable.

Claim 35 has been rejected with the aid of the Turner reference. Turner teaches adhesive, but where does Turner teach using adhesive define and axial channel fold line? Further, the gap in Turner is wide (see fig. 9) and does not aid in finding and creating a predictable fold line.

Claim 36 has been rejected on the same basis, but where in Cunningham is there mention of the adhesive having a differential light transmission characteristic? It is just not there.

Claim 37 has been amended to make clear that the layers are not transparent, as in Cunningham.

New claims 38-40 relate to 3 dimensional label creation. The difficulty in creating 3D labels is insuring that the user can reliably fold them in the right places. If the materials are not transparent and there is no score line, the light transmissibility becomes critical to a proper fold. Cunningham makes no reference to this feature.

In view of the amendments and reasons provided above, it is believed that all pending claims are in condition for allowance. Applicant respectfully requests favorable reconsideration and early allowance of all pending claims.

NOTE: Applicants have petitioned for a suspension of this application to allow for an in person interview by applicant and/or attorney who is not located in the DC area.

If a telephone conference would be helpful in resolving any issues concerning this communication, please contact Applicant's attorney of record, Michael B. Lasky at (952) 253-4106.

Respectfully submitted,  
Altera Law Group, LLC  
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